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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,395	03/14/2001	K. Theodor Krantz	05918-117001	3672

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EXAMINER

BRITTAIN, JAMES R

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/808,395

Applicant(s)

KRANTZ ET AL.

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-83 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 3/1, 4/3/1, 5/4/3/1, 6/5/4/3/1, 7/5/4/3/1, 8/3/1, 9/3/1, 10/9/3/1, 11/1, 12/11/1, 13/1, 14/13/1, 15/1, 16/15/1, 17/16/15/1, 18/1, 19, 20, 21/1, 22/21/1, 23/1, 24/1, 25/1, 26/1, 27/1, 28/1, 29/28/1, 30/29/28/1, 33/1, 34/33/1, 35/1, 36/35/1, 39/35/1, 40/39/35/1, 41/39/35/1, 42/41/39/35/1, 43/36/35/1, 45/43/36/35/1, 51/33/1, 52/1, 53/1, 54/1, 55/1, 56/1, and 80, drawn to a hook fastener product, classified in class 24, subclass 452.
- II. Claims 2, 3/2, 4/3/2, 5/4/3/2, 6/5/4/3/2, 7/5/4/3/2, 8/3/2, 9/3/2, 10/9/3/2, 11/2, 12/11/2, 13/2, 14/13/2, 15/2, 16/15/2, 17/16/15/2, 18/2, 21/2, 22/21/2, 23/2, 24/2, 25/2, 26/2, 27/2, 28/2, 29/28/2, 30/29/28/2, 31, 32, 33/2, 34/33/2, 35/2, 36/35/2, 37, 38, 39/35/2, 40/39/35/2, 41/39/35/2, 42/41/39/35/2, 43/36/35/2, 44, 45/43/36/35/2, 46-50, 51/33/2, 52/2, 53/2, 54/2, 55/2, 56/2, and 69-74, drawn to a composite comprised of loop defining material and loop-engaging hooks, classified in class 24, subclass 450.
- III. Claims 66-68 and 75-79, drawn to hook engageable loop material and a method of making hook engageable loop material, classified in class 24, subclass 448.
- IV. Claims 57-65 drawn to methods of making hook material, classified in class 156, subclass 229.
- V. Claims 81-83, drawn to an apparatus for forming hooks on a surface, classified in class 425, subclass 363.

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The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the elastically stretchy preformed carrier supporting the stems of the hooks as claimed in claim 1 and the base layer having regions between adjacent hook regions in which the base layer is thinner than in the regions in which the stems are integrally joined as claimed in claim 80 are not claimed in the broadest combination claims thereby providing evidence that the particulars of the subcombination are not required. The subcombination has separate utility such as a support for an ornament to be attached to the apertures in a screen.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the loop material comprising a nonwoven material including a binder stabilizing the material so that it is substantially elastically stretchable in only one direction (claims 66 and 75) is not required in the broadest combination claims thereby providing evidence that the particulars of the

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subcombination are not required. The subcombination has separate utility such as a supporting structure secured to a wall to mount picture frames. The product of the combination claims similarly does not require the structure resulting from the method of making the subcombination because the method defines a product of the same scope as the subcombination claims. The combination claim loop structure found in the broadest combination claims can be made by a process comprising a weaving process without a binder and this is a materially different process.

Inventions IV and I, II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as making the product comprising the hook material by a process of providing a substantially flat plate with mold cavities and areas that protrude from the flat plate constructed respectively to form at least the stems of fastener hooks and areas between the hook regions that will be thinner, heating a sheet of plastic material, positioning the sheet of plastic material on top of a carrier, pressing the flat plate against the heated plastic material in a vacuum so as to form the hooks with the bases of the stems against the carrier so that they are *in situ* laminated with the base layer carrier.

Inventions V and I, II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the

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apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as a substantially flat plate with mold cavities and areas that protrude from the flat plate constructed to form at least the stems of fastener hooks, whereby heating a sheet of plastic material, positioning the sheet of plastic material on top of a carrier, pressing the flat plate against the heated plastic material in a vacuum so as to form the hooks with the bases of the stems against the carrier so that they are *in situ* laminated with the base layer carrier.

Inventions IV and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as a substantially cylindrical mold roll having only mold cavities constructed to form the stems of fastener hooks wherein the mold roll and a corresponding pressure roll have both ends of the rolls supported over the web so that neither is cantilevered. The rolls of this alternative apparatus are cylindrical without spacer rings of larger diameter. A cutting apparatus subsequently creates grooves.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention (the groups are listed by reference to the invention numbered as above utilizing Arabic numerals in parentheses):

The subcombination groups drawn to a hook fastener product comprise:

Group I(1) comprising figures 1-1B, 2-2A, 5-5A and 6-6A;

Group II(1) comprising figures 3-3A and 7-7A;

Group III(1) comprising figure 8;

Group IV(1) comprising figures 9F and 9G;

Group V(1) comprising figure 9H;

Group VI (1) comprising figures 15A-15B;

The combination groups drawn to a composite including loop defining material and loop-engaging hooks comprise:

Group I(2) comprising figures 11-11B;

Group II(2) comprising figures 12-12F;

Group III(2) comprising figure 14;

Group IV(2) comprising figures 18-19;

Group V(2) comprising figures 20-23;

Group VI(2) comprising figures 28-28F, 30-34;

Group VII(2) comprising figures 35-38;

The subcombination drawn to hook engageable loop material and a method of making hook engageable loop material comprise:

Group I(3) comprising figures 13A-13C;

Group II(3) comprising figures 25-25A;

Group III(3) comprising figures 26-26A;

Group IV (3) comprising figures 27-27A;

Group V(3) comprising figures 41-42;

The apparatus for forming hooks on a surface comprise:

Group I(5) comprising figures 9B, 9C;

Group II(5) comprising figure 9D;

Group III(5) comprising figure 9E;

Group IV(5) comprising figure 10;

Group V(5) comprising figures 16-17B; and

Group VI(5) comprising figures 29-29B.

If applicant should elect either subcombination (I or III) applicant must elect one group as defined above from the elected subcombination. If applicant should elect the combination (II) applicant must also elect one group as defined above from each subcombination (I, III), consistent with the disclosure providing written description of those subcombinations groups being used in the elected combination. If applicant elects the methods (IV) of making hook material, then applicant must elect a method of making a particular hook material subcombination group (I) from above or if applicant chooses to elect a method of making hook material with loop material then applicant must elect one group as defined above from each subcombination (I, III), consistent with the disclosure providing written description of those subcombinations groups being used in the elected combination. If applicant elects the invention drawn to an apparatus for forming hooks on a surface (V), then applicant must elect an apparatus group from above. The apparatus of figures 45-47 appears to be an overall configuration applicable to any of the groups of apparatus.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic to all species over all inventions.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on Monday - Friday from 5:30 to 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read 'J. R. Brittain', with a stylized flourish at the end.

James R. Brittain
Primary Examiner
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JRB
September 17, 2002